The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NICHOLAS W. NYHAN and RONIT AVIV

MAILED
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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2004-2162
Application 09/349,650[1]

HEARD: March 8, 2005

Before HAIRSTON, BARRETT, and LEVY, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-18 and 20-50. Claim 19 has been canceled.

We reverse.

[1] Application for patent filed July 8, 1999, entitled "System and Method for Evaluating and/or Monitoring Effectiveness of On-Line Advertising."

BACKGROUND

The invention relates to a computer method and system that aids in the tracking of users' exposure to advertisements submitted by an advertisement server. A code is associated with an ad such that, when the ad is executed, the user computer sends a signal to a server, and the server responsively provides an indicator which stored within a file on the user computer. The indicator of exposure to an advertisement may be a "cookie." A survey presented to the user can use the stored indications to determine the effectiveness of the advertising.

Claim 1 is reproduced below.

> 1. A system for facilitating measuring effectiveness of advertisements displayed upon a computer for viewing by a user, the system comprising:
>
> a code associated with an advertisement received from an advertiser server;
>
> a server capable of supplying an indicator identifying an instance wherein the advertisement is activated for viewing by the user, and wherein the code initiates sending a signal to the server indicative of activation of the advertisement; and
>
> a computer on which the advertisement is activated for viewing by the user wherein the computer has a file within which the indicator is stored, the indicator providing information associated with the advertisement.

THE REFERENCES

The examiner relies on the following references:

Dedrick	5,724,521	March 3, 1998
Goldhaber et al. (Goldhaber)	5,794,210	August 11, 1998

THE REJECTIONS

Claims 1-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dedrick.

Claims 1-18 and 20-50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Goldhaber.

We refer to the final rejection (Paper No. 12) and the examiner's answer (Paper No. 19) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (Paper No. 18) (pages referred to as "Br__") and reply brief (Paper No. 20) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

Reservation of argument clauses not given weight in brief

With respect to the grouping of claims, appellants state that the claims do not stand or fall together and each one stands or falls on its own, but, to simplify the appeal, the claims are put into two groups: claims 1-18 and 20, and claims 21-50 (Br6). Appellants assert (Br6): "Notwithstanding Appellants' grouping of the claims, Appellants incorporate by reference, and explicitly reserve the right to reassert, each and every ground set forth in any preceding Office Action response to the extent needed to distinguish the invention from the prior art." Appellants further state that they reserve the right to traverse the dependent claims (Br8; Br9; Br10).

The U.S. Patent and Trademark Office rule in effect when appellants brief was filed states that "[a]ny arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown." 37 CFR § 1.192(a) (2002). All arguments should be presented in the brief. Incorporation by reference, while acceptable in some legal situations, is not acceptable in briefs before the Board where an appellant's arguments should be self-contained. It would be unduly burdensome for the panel to have to sort through the record and the prosecution history to determine appellants' argument, which may be spread out over several responses. In view of the fact that most responses to the Office are prepared with word processors, putting the actual material into the brief should not be difficult for an applicant. However, since the rejections are reversed, the reservation arguments are moot.

Dedrick

The examiner finds: (1) Dedrick must have "a code associated with an advertisement received from an advertiser server" so that the metering servers 14 can identify the advertiser and forward the information to the clearinghouse server 20 for crediting/debiting the advertiser's account (EA5); (2) the limitation, "a server capable of supplying an indicator identifying an instance wherein the advertisement is activated

for viewing by the user," corresponds to the metering server 14 of Fig. 1 (EA5); (3) the limitation, "the code initiates sending a signal to the server indicative of activation of the advertisement" corresponds to the statistic compilation process 26 on the user computer sending back an indication of how much time was spent consuming the advertisement (EA5); and (4) the limitation, "a computer on which the advertisement is activated for viewing by the user wherein the computer has a file within which the indicator is stored, the indicator providing information associated with the advertisement" corresponds to the user computer and the indicator is "the indicator providing information associated with the advertisement such as how many Ad screens were viewed by the user" (EA5).

Appellants argue that "Dedrick does not disclose or suggest a code associated with an ad such that, when the ad is executed, the user computer sends a signal to a server, and the server responsively provides an indicator stored within a file on the user computer" (Br8), as recited in claim 1.

The examiner finds that these limitations are not claimed in claim 1 (EA23). The examiner states that "[t]he issue before the Board is whether or not the user's interaction with a displayed advertisement is being monitored and an indication of this monitoring or interaction data is saved or stored on the user's computer 12 [h]ard disk drive" (EA26).

Appellants argue that the examiner's assertion is not well founded and points out the correspondence between appellants' argument and the claim limitations (RBr4). It is argued that the issue is not whether exposure information is stored upon the user's computer, as stated by the examiner: it is acknowledged that "[i]n both Dedrick and Appellants' claim 1 the exposure information is stored upon the user's computer" (RBr5). The real issue, appellants state, "involves 'how' (i.e., the sequence of actions through which) the exposure data is stored on the user's computer" (RBr5).

It is not clear to us why the examiner considers that the limitations argued by appellants are not claimed, unless the examiner is relying on absence of literal language. Claim 1 recites "a code associated with an advertisement received from an advertiser server." Claim 1 recites "a computer on which the advertisement is activated for viewing by the user" and that "the code initiates sending a signal to the server indicative of activation of the advertisement," although in different order, which supports appellants' argument that "when the ad is executed, the user computer sends a signal to a server" (Br8). Although claim 1 does not specifically call the "computer on which the advertisement is activated for viewing by the user" a "user computer," appellants are clearly not trying to argue a limitation which is not in claim 1. Claim 1 recites "a server

capable of supplying an indicator identifying an instance wherein the advertisement is activated for viewing by the user" and "wherein the computer [on which the advertisement is activated by the user] has a file within which the indicator is stored, the indicator providing information associated with the advertisement." Thus, claim 1 supports appellants' argument that "the server responsively provides an indicator stored within a file on the user computer" (Br8). It does not appear that the examiner fully appreciates the claimed invention, especially the limitation that the server sends the indication of exposure to the user computer to be stored in the user computer.

Dedrick does not anticipate claim 1. We assume, as stated by the examiner, that the advertisements in Dedrick have some identification code to identify the advertiser for tracking billing purposes. It is not clear whether "the code initiates sending a signal to the server indicative of activation of the advertisement" or whether the statistic compilation process 26 (col. 9, lines 28-48) performs this function. Nevertheless, this is not the real issue. The metering server 14, which the examiner finds to be the claimed "server," does not supply an "indicator identifying an instance wherein the advertisement is activated for viewing by the user" back to the user computer (the "computer on which the advertisement is activated ... by the user"), which indicator is stored in a file on the user computer.

In appellants' disclosed invention, this corresponds to sending a "cookie." The examiner's reading of Dedrick does not account for this difference. We agree with appellants that the issue is not whether exposure information is stored upon the user's computer, but the sequence of actions through which it is stored on the user's computer. The rejection of claims 1-12 is reversed.

Goldhaber

Claims 1-12

As to claim 1, the examiner finds: (1) the limitation, "a code associated with an advertisement received from an advertiser server," corresponds to a cybercoin 62 of Fig. 4 or simply a filename associated with an advertisement (EA9); (2) the limitation, "a server capable of supplying an indicator identifying an instance wherein the advertisement is activated for viewing by the user," corresponds to the advertiser web server or the attention broker server 106 (EA10); (3) the limitation, "the code initiates sending a signal to the server indicative of activation of the advertisement" corresponds to the cybercoin 62 sending a signal to the advertiser web server or attention broker server by the user who was given the incentive to read the advertisement (EA10); and (4) the limitation, "a computer on which the advertisement is activated for viewing by the user wherein the computer has a file within which the indicator is stored, the indicator providing information

associated with the advertisement" corresponds to the user computer 104 where the data regarding the user's interaction can be stored either on the attention broker server or the user computer thereby preventing the user from viewing (and being paid for viewing) the same advertisement more than once (EA10).

Appellants argue that the "cybercoin" is not a "code," as claimed (Br8). It is argued that the claimed code "initiates sending a signal to the server indicative of activation of the advertisement" with which the code is associated and, as such, the advertisement must already have been loaded on the computer and activated when the code executes to initiate sending the signal to the server (Br8).

The examiner responds that the arguments about the code are not supported by the claims (EA26). The examiner finds (EA27):

> The displayed advertisement, as herein understood, having an embedded code that causes the computer 104 to send a first signal, indicative of the user's activation and the user's interaction with the said advertisement, upward to the Attention Brokerage Server 106 (administration server), which returns a message or a second signal or a digital cash, in the form of a computer code, related to the advertisement and representative of the Cybercoin 62 to the user's computer 104 to be stored in a digital cash repository 126 subsequent to determining by the Server 106 that the user has successfully completed the process (col. 16: 6-15).

Appellants reply that the examiner mischaracterizes the teachings of Goldhaber, e.g., nowhere does Goldhaber disclose that the digital cash "signal" is transferred from a server down to a user's computer 104 where it is subsequently stored (RBr5).

It is argued that it makes no sense to place the consumer database 120 (including the digital cash 126) on a user's computer where it can be tampered with (RBr5-6).

Initially, we agree with appellants that a "cybercoin" is not a "code associated with an advertisement ... wherein the code initiates sending a signal to the server indicative of activation of the advertisement," as recited in claim 1. Clicking on the cybercoin icon initiates retrieval of the associated advertisement (col. 16, lines 6-10); it does not initiate sending a signal. Nevertheless, the examiner's reasoning in the response to the argument section relies on code associated with the advertisement and backs away from reliance on the cybercoin (EA27). We agree, and think appellants do not dispute, that there is code associated with the advertisement that requires consumer interaction (col. 16, lines 10-13). A software process running on the user computer 104 collects interaction data (col. 16, lines 44-48; Fig. 12, block 202) and sends it to an attention brokerage server 106 (col. 16, lines 57-62 and 65-67; Fig. 12, block 212) where it is determined whether the user's interaction was adequate (col. 17, lines 33-35; Fig. 12, block 228). Thus, Goldhaber discloses "code associated with an advertisement ... wherein the code initiates sending a signal to the server indicative of activation of the advertisement." If the user's response is adequate, the attention brokerage

server 106 updates the user's account to credit (or direct pay) the consumer the monetary value represented by the activated cybercoin 62 and updates its database to inactivate this particular cybercoin to prevent the user from receiving additional compensation by repeating the same process (col. 17, lines 44-53; Fig. 12, blocks 230 and 232).

We agree with appellants that Goldhaber does not disclose "the [user] computer has a file within which the indicator is stored, the indicator providing information associated with the advertisement." It appears that consumer database 120 in Fig. 7 can be stored on either the consumer computer 104 and/or at attention brokerage servers 106 (col. 12, lines 38-41, the database is created by the user computer; col. 14, lines 41-43, storing the consumer interest profile; col. 11, lines 33-44, the digital cash may be stored on the consumer computer 104 or a financial computer 108). However, the consumer database 120 does not contain "information associated with the advertisement." We disagree with the examiner's finding that Goldhaber discloses storing information regarding the user's interaction with the advertisement either on the attention broker server or the user computer, in particular, storing it on the user computer. Goldhaber discloses that the "attention brokerage server 106 ... updates its database to inactivate this particular CyberCoin (to prevent the consumer from receiving additional compensation by

merely successively repeating the same process for the same ad) (FIG. 12, block 232)" (col. 17, lines 46-52; note that the attention brokerage server activity takes place on the right side of Fig. 12). The database updated is the attention brokerage server 106 database. There is no teaching or suggestion that the indicator associated with the advertisement (indicating that the advertisement has been watched) is or can be stored on the user computer 104. It makes no sense to store the indicator on the user computer because there it could be tampered with to allow the user to successively earn cybercash by changing the indication. Therefore, Goldhaber does not anticipate claim 1. The rejection of claims 1-12 is reversed.

Claims 13-18 and 20-50

All of the independent claims recite a code associated with an advertisement such that the user computer sends a signal to a server (or administration computer) when the advertisement is activated. Claim 1 recites "sending a signal to server indicative of activation of the advertisement." Claim 13 recites an "advertisement ... activated upon a computer for viewing by a user" and "identifying an instance wherein the advertisement has been activated ... for viewing by the user and initiating sending a signal to a server." Claim 18 recites "generating a signal when the advertisement is activated on the computer." Claim 21 recites "generating a signal, in association with activation of

the advertisement message upon the user computer, to the administration computer." Claim 34 recites "generating, by the user computer, ... in association with activation of the advertisement upon the user computer, a signal for an administration computer."

All of the independent claims recite that the server responsively provides an indicator (or information) associated with the advertisement which is stored on the user computer. Claim 1 recites "a server capable of supplying an indicator" and "wherein the computer [on which the advertisement is activated by the user] has a file within which the indicator is stored, the indicator providing information associated with the advertisement." Claim 13 recites "storing information in the computer of the user provided by the server wherein the information relates to activation of the advertisement." Claim 18 recites "the server generates a second signal ... wherein the second signal includes information related to the activation of the advertisement and is stored on the computer of the user." Claim 21 recites "storing ... within the memory of the user computer a value received from the administration computer ... indicative of activation of the advertisement message." Claim 34 recites "storing within memory on the user computer a value received from the administration computer ... indicative of the activation of the advertisement." As discussed in connection

with claim 1, Goldhaber does not disclose that an indicator (or information) associated with the advertisement stored on the user computer is provided by the server (or administration computer). Accordingly, the rejection of claims 13-18 and 20-50 is likewise reversed.

CONCLUSION

The anticipation rejection of claims 1-12 over Dedrick is reversed. The anticipation rejection of claims 1-18 and 20-50 over Goldhaber is reversed.

REVERSED

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